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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,873	03/16/2004	Masakatsu Kiwada	011350-329	1558

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EXAMINER
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CRUZ, IRIANA

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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12/29/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/800,873	<b>Applicant(s)</b> KIWADA, MASAKATSU	
	<b>Examiner</b> IRIANA CRUZ	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,6,7,12,13,18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,7,12,13,18 and 20-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/16/2004-11/21/2007</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 21-23, 25-27 and 29-31 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments, see page 6, filed 05/29/2008, with respect to the rejection(s) of claim(s) 1, 6-7, 13, 18, 20, 24 and 28 under Terarura and Nishigai have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Terarura, Ojha and Nishigai.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim(s) 13-14 and 18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 13-14 and 18 is drawn to functional descriptive material recorded on a computer readable medium. The way the claim is written appears it is claiming the program (functional descriptive material) but not the computer readable medium.

Examiner suggest the claim be changed to "a computer readable medium storing an image forming program."

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 21-23, 25-27 and 29-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims specifically claim "a first judgment unit for judging whether a series of documents set on document tray contains at least one electronically tagged printed matter that includes an electronic tag storing original image data" and "a second judgment unit for individually judging whether each of the documents by the transporting unit is an electronically tagged printed matter..". In the specification an operation unit is said to determine whether the document contains an IC-tagged document or not but nowhere in the specification is specifically referred to a first judgment unit and a second judgment unit where the second judgment unit individually judges whether each of the documents transported is an electronically tagged printed matter.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 6-7, 13, 18, 20, 24 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terarura (US Patent Number 6,827,279 B2) in view of Ojha (US Patent Number 4,987,447) and further in view of Nishigai et al. (US Patent Number 5,825,911).

Regarding **Claim 1**, Terarura'279 shows an image forming device comprising: a transporting unit for transporting a document sheet by sheet to a specified reading position (**i.e., image reading means for reading an image on a sheet of paper of a document; document paper feeder. See Column 2, Lines 29-30, See Column 5, Lines 39-43 and See Figure 2, Element 4**); a document judgment unit for judging whether the document transported by said transporting unit is an electronically tagged printed matter that includes an electronic tag (**i.e., detecting/judging means that detect if the paper includes an RFID/electronic tag. See Column 1, Lines 50-65, Column 2, Lines 10-38 and Column 7, Lines 3-23**); a printing paper judgment unit for judging whether there is an instruction for printing image data on an electronically tagged printing paper equipped with an electronic tag (**i.e., paper feeding means having a first paper tray with electronic tags and second paper tray with paper without electronic tags, when a detection of electronic tag is done the printer prints using the electronically tagged paper. See Column 1, Lines 30-65 and Column 2, Lines, 1-26**); a reading unit for reading the data from the electronic tag of the document which is judged as said electronically tagged printing matter by said document judgment unit, when said printing paper judgment unit judges

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that there is an instruction for printing on an electronically tagged printing paper equipped with a electronic tag (**i.e., a RFID data reading means to read data from the electronic tag. See Column 1, Lines 30-65 and Column 2, Lines, 1-40**); and a printing unit for printing the data on an electronically tagged printing paper equipped with an electronic tag, wherein the data is read by said reading unit (**i.e., printing detected page data with electronic tag on a paper from the tray with electronic tags. See Column 1, Lines 30-65**).

Terarura'279 fails to show the information received by the image forming apparatus through the electronic tag to be original image data to be used for printing instructions.

Ojha'447 teaches an image forming apparatus receiving original image data to be used for printing instructions (**i.e., detection means detect if the document page being read is a control sheet, the control sheet is produced from instruction signals and coded information with setup instruction signals for controlling the subsequent run of the reproduction apparatus/printer, this control sheet contains page data, setup instructions for printing an original data, ((original image data)). See Column 1, Lines 49-60, See column 2, Lines 60-67 and See Column 3, Lines 18-56**).

Having the system of Terarura'279 with the judging unit for detecting electronic data on document pages and then given the well-established teaching of the Ojha'447, having instruction for original image data, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system as suggested by the combination of Terarura'279 with

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the teachings of Ojha'447, by having the original image data instead of saved in a control sheet, just be saved in the electronic tag on the document page in order to improve the system efficiency and use of resources by just having the information needed inside the electronic data instead of having to use a whole control sheet for the information.

The combination of Terarura'279 and Ojha'447 fails to show said printing step to issue a blank paper as an output, when a document is judged one specific way.

Nishigai'911 teaches a printing step to issue a blank paper as an output, when a document is when a document is judged one specific way **(i.e., an image forming apparatus that by means of a light source to inspect a document judges the authenticity of a document if the document is judge with forgery the image forming apparatus outputs a blank sheet of paper. See Column 2, Lines 58-66, Column 3, Lines 9-13 and See Column 13, Lines 43-45).**

Having the method of Terarura'279 and Ojha'447 and then given the well-established teaching of the Nishigai'911, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the method of Teraura'279 as taught by the Nishigai'911 by adding to the image forming apparatus with electronic tag judging means the step of printing a blank page when a judgment is done, in this case if its judged that there is no electronic tag on the paper being read, the printed blank page will let the user know there is no electronic tag for the printer to print, since printing a blank page helps improve the method by letting the user know its trying to print unauthorized/invalid

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information and protects forgery/errors as suggested in reference Teraura'279 Column 2, Lines 55-57.

Regarding **Claim 6**, Teraura'279 shows the image forming apparatus wherein said electronic tag transmits or receives electronic data by means of wireless communications (**i.e., the RFID/electronic tag transmits and receives data through radio waves signals. See Column 4, Lines 22-23 and 49-51).**

With regards to method **Claim 7**, the limitation of the claim 7 are corrected by limitation of claim 1 above. The steps of claim 7 read into the function step of claim 1.

With regards to method **Claim 12**, the limitation of the claim 12 are corrected by limitation of claim 6 above. The steps of claim 12 read into the function step of claim 6.

With regards to method **Claim 13**, the limitation of the claim 13 are corrected by limitation of claim 1 above. The steps of claim 13 read into the function step of claim 1.

With regards to method **Claim 18**, the limitation of the claim 18 are corrected by limitation of claim 6 above. The steps of claim 18 read into the function step of claim 6.

Regarding **Claim 20**, Terarura'279 shows an image forming device comprising: a transporting unit for transporting a document sheet by sheet to a specified reading position (**i.e., image reading means for reading an image on a sheet of paper of a document; document paper feeder. See Column 2, Lines 29-30, See Column 5, Lines 39-43 and See Figure 2, Element 4); a**



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document judgment unit for judging whether the document transported by said transporting unit is an electronically tagged printed matter that includes an electronic tag **(i.e., detecting/judging means that detect if the paper includes an RFID/electronic tag. See Column 1, Lines 50-65, Column 2, Lines 10-38 and Column 7, Lines 3-23)**; a printing paper judgment unit for judging whether there is an instruction for printing image data on an electronically tagged printing paper equipped with an electronic tag **(i.e., paper feeding means having a first paper tray with electronic tags and second paper tray with paper without electronic tags, when a detection of electronic tag is done the printer prints using the electronically tagged paper. See Column 1, Lines 30-65 and Column 2, Lines, 1-26)**; a reading unit for reading the data from the electronic tag of the document which is judged as said electronically tagged printing matter by said document judgment unit, when said printing paper judgment unit judges that there is an instruction for printing on an electronically tagged printing paper equipped with a electronic tag **(i.e., a RFID data reading means to read data from the electronic tag. See Column 1, Lines 30-65 and Column 2, Lines, 1-40)**; and a printing unit for printing the data on an electronically tagged printing paper equipped with an electronic tag, wherein the data is read by said reading unit **(i.e., printing detected page data with electronic tag on a paper from the tray with electronic tags. See Column 1, Lines 30-65).**

Terarura'279 fails to show the information received by the image forming apparatus through the electronic tag to be original image data to be used for printing instructions.

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Ojha'447 teaches an image forming apparatus receiving original image data to be used for printing instructions (**i.e., detection means detect if the document page being read is a control sheet, the control sheet is produced from instruction signals and coded information with setup instruction signals for controlling the subsequent run of the reproduction apparatus/printer, this control sheet contains page data, setup instructions for printing an original data, ((original image data)). See Column 1, Lines 49-60, See column 2, Lines 60-67 and See Column 3, Lines 18-56).**

Having the system of Terarura'279 with the judging unit for detecting electronic data on document pages and then given the well-established teaching of the Ojha'447, having instruction for original image data, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system as suggested by the combination of Terarura'279 with the teachings of Ojha'447, by having the original image data instead of saved in a control sheet, just be saved in the electronic tag on the document page in order to improve the system efficiency and use of resources by just having the information needed inside the electronic data instead of having to use a whole control sheet for the information.

The combination of Terarura'279 and Ojha'447 fails to show said printing step to issue no output, when a document is judged one specific way.

Nishigai'911 teaches a printing step to issue no output, when a document is when a document is judged one specific way (**i.e., an image forming apparatus that by means of a light source to inspect a document judges the**

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**authenticity of a document if the document is judge with forgery the image forming apparatus outputs no output. See Column 2, Lines 58-66, Column 3, Lines 9-13 and See Column 13, Lines 46-47).**

Having the method of Terarura'279 and Ojha'447 and then given the well-established teaching of the Nishigai'911, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the method of Teraura'279 as taught by the Nishigai'911 by adding to the image forming apparatus with electronic tag judging means the step of printing no output page when a judgment is done, in this case if its judged that there is no electronic tag on the paper being read, there is no output which will let the user know there is no electronic tag for the printer to print, since printing no output helps improve the method by letting the user know its trying to print unauthorized/invalid information and protects forgery/errors as suggested in reference Teraura'279 Column 2, Lines 55-57.

With regards to method **Claim 24**, the limitation of the claim 24 are corrected by limitation of claim 20 above. The steps of claim 24 read into the function step of claim 20.

With regards to method **Claim 28**, the limitation of the claim 28 are corrected by limitation of claim 20 above. The steps of claim 28 read into the function step of claim 20.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IRIANA CRUZ whose telephone number is

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(571)270-3246. The examiner can normally be reached on Monday-Friday  
7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax  
phone number for the organization where this application or proceeding is  
assigned is 571-273-8300.

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/King Y. Poon/  
Supervisory Patent Examiner, Art Unit 2625

Iriana Cruz  
Examiner  
Art Unit 2625

December 17, 2008

/I. C./  
Examiner, Art Unit 2625